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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,005	08/06/2001	Juergen Bruegl	951/49937	6897

7590 06/17/2003

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EXAMINER

CALEY, MICHAEL H

ART UNIT PAPER NUMBER

2871

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,005

Applicant(s)

BRUEGL ET AL.

Examiner

Michael H. Caley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 09 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 8 is objected to because of the following informalities: Appropriate correction is required.

In the second to last line, "monetary" should be replaced with --momentary--

Response to Amendment

Applicant's arguments filed 4/9/03 have been fully considered but they are not persuasive.

Applicant has amended claims 1 and 5 to include a setting mechanism arranged between the picture source and the picture transmission device, whereby the picture transmission device can be secured in its momentary position after a torsion movement in the fiber optics section. Such language does not sufficiently identify whether the setting mechanism is functional to secure the picture transmission device in its momentary position, only that it is arranged between the picture source and the picture transmission device. Additionally, no limitation is present to identify the purpose or construction of the setting mechanism. Thus, the setting mechanism may be interpreted as being a mechanical stabilizer such as part of the bendable material surrounding the fiber optics section, as a focusing mechanism, or as a clamp to an external body.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cole in view of Gerwers.

Regarding claims 1, Cole discloses:

- a fiberscope having:
- a picture source (Figure 1, element 12, A);
- a picture transmission device including a fiber optics section (Figure 1 element 22;
- an eyepiece (Figure 1 element 64).

Cole discloses the sheathing (Figure 1 element 66) as flexible (Column 4 lines 30-37), but is silent on whether the material exhibits a property of remaining in the shape assumed by bending. Gerwers, however, describes several embodiments of a protective sleeve for scope probes in which the sleeve remains in a shape assumed by bending it (Column 2 lines 59-64; Column 3 lines 1-4). "Bellows-like flexible stainless steel" and "shape-memory alloy" as described in the reference are both considered by the Examiner to have a property in which the

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material remains in a shape assumed by bending and furthermore is a material designed and suitable for bending.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used sheathing with a shape memory property in Cole's fiberscope design as a means of protecting the optical fibers and assuring that the fiberscope remains in an intended orientation after placement. Such a design would allow for the fiberscope to be placed without further constraints or restrictive elements to maintain the orientation and shape of the fiberscope. The addition of a sheathing with shape memory would be advantageous in applications in which it is desired that the fiberscope maintain a predetermined orientation, but no constraint or restrictive element is available outside of the fiberscope to maintain its shape and orientation, such as inserting the fiberscope into a chamber as described by Gerwers (Figure 1). Furthermore, the protective sleeve may function as a setting mechanism arranged between the picture source and the picture transmission device, whereby the picture transmission device can be secured in its momentary position after a torsion movement of the fiber optics section.

Claims 3 and 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Cole in view of Gerwers and in further view of Lerner.

Cole and Gerwers disclose all of the proposed limitations except for an eyepiece with a setting mechanism for setting the optical elements. Lerner, however, discloses a diopter adjustment for adjusting a fiberscope eyepiece to an individual's eyesight.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a setting mechanism for setting the optical elements of a fiberscope

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to an individual's eyesight. Such a mechanism is old and well known in the art for correctly focusing light from an eyepiece to a viewer's eye. The adjustment mechanism would have been advantageous to make the eyepiece adjustable for different viewers and different shapes of eye sockets in order to adjust the focal point of the light emitted from the fiberscope.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerwers.

Regarding claim 5, Gerwers discloses:

- a picture source (Figure 1, end of element 14);

- an eyepiece (Figure 1 element 76);

- an elongate plastically deformable picture transmission device which mechanically and optically couples said picture source and said eyepiece which may function as a setting mechanism arranged between the picture source and another portion of the picture transmission device, whereby the picture transmission device can be secured in its momentary position after a torsion movement in the picture transmission device.

Gerwers fails to designate a separate portion of the picture transmission device as a setting mechanism. Gerwers, however, teaches a deformable transmission device with shape memory such that the device may be treated as both a transmission device and a setting mechanism in which a portion serves as a transmission device and another portion serves to bend as a setting mechanism in addition to being part of the transmission device.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a portion of the transmission device as a setting mechanism for the

device. The sheath of Gerwers' transmission device is designed as such to be able to retain a shape as given. It would have been advantageous to the user to effect such a retained bend in the transmission device at a point adjacent to the picture source as an expediency to attain a particular viewing position of the scope.

Regarding claim 6, Gerwers discloses the picture transmission device as a fiber optic section (Column 1 lines 55-60). The plastically deformable sheathing surrounds at least a part of the fiber optic section (Figure 1 element 12).

Regarding claim 7, the sheathing comprises a metallic material (Column 2 lines 59-61).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerwers in view of Hopkins (U.S. Patent No. 3,994,557).

Gerwers discloses all of the proposed limitations except for an adjusting means within the eyepiece as proposed. Hopkins, however, teaches such an eyepiece functional to change the orientation of the viewed image in an endoscope by the rotation of a prism (Figure 1 elements 42 and 44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included such an adjusting and setting means in the eyepiece to correct the rotational orientation of the viewed image within the eyepiece. Gerwers device experiences a similar problem as taught by Hopkins in that the orientation of the viewed image depends on the arrangement of the optics between the picture source and the eyepiece, particularly in the orientation of the picture source in the case of Gerwers' device. Gerwers fails to divulge the particularities of the chosen eyepiece for the device, however, one of ordinary skill would be

motivated to improve upon it, by adding such an adjusting means as taught by Hopkins in order to add the functionality of orienting the image within the eyepiece. Such an addition would have been advantageous to allow the user to view objects within an adjustably familiar orientation to facilitate an optimal view of the object.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael H. Caley whose telephone number is (703) 305-7913. The examiner can normally be reached on M-F 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Kim can be reached on (703) 305-3492. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

mhc

mhc

June 9, 2003

David V. Bruce

DAVID V. BRUCE
PRIMARY EXAMINER